

REMARKS/ARGUMENTS

In response to the Office Action mailed May 18, 2004, Applicant amends this application and requests reconsideration in view of the amendments and the following remarks. In this Amendment, Claims 1 and 2 are amended, Claims 3 and 4 are withdrawn from consideration and no claims have been added or cancelled, so that Claims 1-4 are pending. No new matter has been introduced.

Applicant elects Claims 1 and 2.

Claims 1 and 2 were rejected under 35 USC 101. Applicant respectfully traverses.

In making the rejection, the Examiner contends that the apparatus claimed cannot function because in order for it to work, the conduits must pass through the thoracic wall and lung of a patient. Applicant respectfully submits the following clinical journal articles that describe procedures where an emphysematous lung is punctured and a catheter is implanted in the lung tissue through the puncture site for a period anywhere from eight to thirty-three days. In addition, there are articles that address lung drainage wherein the lung is punctured for access. Also, there is a reimbursement code for puncturing the lung.

Hospital In-Patient Procedure:

33.93 Puncture of lung: Assignment to DRG 76 or 77 (\$5,600/\$13,000)
depending on a qualifying complication or co-morbidity (cc)

Accordingly, as explained on page 14 of the specification, the lungs may be safely punctured. Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

Claim 1 was rejected as being anticipated by U.S. Patent No. 3,682,166 to Jacobs (Jacobs). This rejection is respectfully traversed.

Anticipation exists only if all of the elements of the claimed invention are present in a system or method disclosed, expressly or inherently, in a single prior art reference. Therefore, if it can be shown that there is one difference between the claimed invention and what is disclosed in the single reference, there can be no anticipation.

Jacobs discloses an emergency tracheotomy instrument and ventilating apparatus for restoring breathing in non-breathing patients. The tracheotomy instrument includes a catheter assembly and needle for accessing the trachea. The ventilating apparatus comprises a pressurized source of oxygenated gas and a vacuum source. In addition, the ventilating apparatus comprises a number of conduits for interconnecting the patient to the two devices.

Jacobs fails to disclose or even suggest an oxygen supply, at least one conduit configured to pass through the thoracic wall and lung of a patient and a sealing device configured to provide a seal between the conduit and the thoracic wall. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claim 2 was rejected as being unpatentable over Jacobs in view of U.S. Patent No. 4,502,482 to DeLuccia, deceased et al., (DeLuccia). This rejection is respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d, 488, 20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

DeLuccia discloses an endotracheal complex for insertion into the trachea of a patient. The endotracheal complex is utilized to administer oxygen and/or anesthetic gases into the lung of a patient through the trachea.

The references, whether taken alone or in combination fail to disclose or even remotely suggest an oxygen supply, valves, conduits and multiple sealing means for providing seals between the conduit and the thoracic wall and bronchus.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed.Cir.1998). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *In re Demiczak*, 175 F.3d 994, 999 (Fed.Cir.1999). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1998).


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Based upon a reading of the two references, there is simply no motivation to combine the references. Accordingly, for all the reasons set forth herein, reconsideration and withdrawal of the rejection is respectfully requested.

Applicant would be willing to interview the present case with the Examiner .
Accordingly, the Examiner is invited to call the undersigned at 732-524-2581 if such a call would facilitate the prosecution of this application.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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